

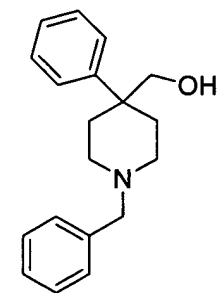
### **Remarks**

Claims 1 and 92-108 are pending. Claims 92, 94, 98, and 100 have been amended. New claims 101-108 were added. The definition of variable  $R_5$  in claim 92 was amended in order to bring the claim into conformity with the restriction requirement. Support for the amendment to claim 92 can be found, for example, on page 11 of the application. Since Invention I of the restriction requirement includes compounds where  $R_5$  is thiophene, claims 101-108 were added. Support for claims 101-108 is provided throughout the application as originally filed. For example, support for Formula A and the attendant definitions in claim 101 is provided on pages 11 and 18 of the application. Support for claims 102-108 can be found, for example, on pages 11, 18, 19, 77, and 78 of the application. Therefore, no new matter has been added. Importantly, the claim amendments should not be construed to be an acquiescence to any of the claim rejections. Rather, the amendments to the claims are being made solely to expedite prosecution of the above-identified application. The Applicant expressly reserves the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120.

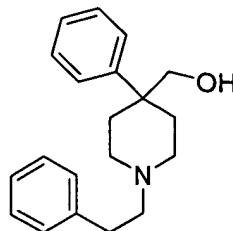
### **Response to Claim Rejections Based on 35 USC § 102(b)**

*Yamato Masatoshi et al. English Abstract DN94:57952*

Claims 1 and 92 stand rejected under 35 USC § 102(b), based on the Examiner's contention that they are anticipated by Yamato Masatoshi *et al.* disclosing compounds RN#59083-36-2 and RN#63080-12-6. Applicants presume that the Examiner intended "RN#59083-36-2" instead of "RN#590383-36-2" because the chemical structure provided in the Office Action corresponds to RN#59083-36-2. Compounds RN#59083-36-2 and RN#63080-12-6 are depicted below to support the discussion.



RN#59083-36-2



RN#63080-12-6

The Applicants respectfully traverse the rejection of claim 1 on grounds that neither RN#59083-36-2 nor RN#63080-12-6 fall within the scope of formula A. Compounds RN#59083-36-2 and RN#63080-12-6 both contain an unsubstituted phenyl group tethered to the nitrogen atom of the piperidine moiety. In contrast, claim 1 requires that variable R<sub>5</sub> is a “substituted phenyl group.”

In order to expedite prosecution, claim 92 was amended so that R<sub>2</sub> does not include “-CH<sub>2</sub>OH.” Support for the definition of variable R<sub>2</sub> and R<sub>6</sub> in amended claim 92 is provided by the definition of variables R and R<sub>2</sub> of formula A on page 18 of the application. Amended claim 92 does not read on compound RN#63080-12-6 of *Yamato Masatoshi et al.* because R<sub>2</sub> does not include “-CH<sub>2</sub>OH.” In view of the amendment to claim 92, dependent claims 94, 98, and 100 were amended to require that R<sub>2</sub> represents R<sub>6</sub>O-alkyl and R<sub>6</sub> is acyl. Support for the amendment to claims 94, 98, and 100 is provided by the definition of variables R and R<sub>2</sub> of formula A on page 18 of the application in combination with the embodiments described on pages 18-19 and 77-78 of the application.

Accordingly, the Applicants respectfully request withdrawal of the rejection under 35 USC § 102(b) based on *Yamato Masatoshi et al.* English Abstract DN94:57952.

*GB 815926 and US 2966491*

Claims 1 and 92-100 stand rejected under 35 USC § 102(b), based on the Examiner’s contention that they are anticipated by GB 815926 and US 2966491 disclosing compound RN#855291-79-1. The Applicants respectfully traverse on grounds that compound RN#855291-79-1 does not fall within the scope of formula A in any of claims 1 or 92-100. For example, the “-CO<sub>2</sub>H” group located at the C4-position of the piperidine ring in RN#855291-79-1 does not fall within the scope of R<sub>2</sub> in claims 1 and 92. Accordingly, the Applicants respectfully request withdrawal of the rejection under 35 USC § 102(b) based on GB 815926 and US 2966491.

*GB 817357*

Claims 1 and 92-100 stand rejected under 35 USC § 102(b), based on the Examiner’s contention that they are anticipated by English Abstract DN 54:39146 of GB 817357 disclosing the hydrochloride salt of 1-(m-chlorophenethyl)-4-phenyl-isonipecotic acid. The Applicants respectfully traverse on grounds that the cited compound does not fall within the scope of

formula A in any of claims 1 or 92-100. For example, the “-CO<sub>2</sub>H” group located at the C4-position of the piperidine ring in the hydrochloride salt of 1-(m-chlorophenethyl)-4-phenyl-isonipecotic acid does not fall within the scope of R<sub>2</sub> in claims 1 and 92. Accordingly, the Applicants respectfully request withdrawal of the rejection under 35 USC § 102(b) based on English Abstract DN 54:39146 of GB 817357.

**Response to Claim Rejections Based on 35 USC § 103(a)**

Claims 1 and 92 stand rejected under 35 USC § 103(a), based on the Examiner’s contention that the claims are unpatentable over Rehse *et al.*, Chemical Abstracts 106:18327. Specifically, the Examiner states the “rejection of claims 1 and 92 over Rehse *et al.* 1986 DN 106:18327 has been changed to a 103 since applicants have just changed the ‘n’ from 0-2 to 0 and 1” and “[compounds having] a difference of one -CH<sub>2</sub>-...are considered to be *prima facie* obvious variants.” The Applicants respectfully traverse.

The compounds of claims 1 and 92 are not homologs of the compounds advanced by the Examiner in Rehse *et al.* Chemical Abstracts 106:18327. All of the compounds in Rehse *et al.* Chemical Abstracts 106:18327 advanced by the Examiner against claims 1 and 92 possess a “CH<sub>2</sub>N” moiety at the position corresponding to R<sub>2</sub> in claims 1 and 92. In contrast, claim 1 requires that “R<sub>2</sub> represents RO-CH<sub>2</sub>, RS-alkyl, or RS-cycloalkyl,” and claim 92 requires that “R<sub>2</sub> represents R<sub>6</sub>O-alkyl, RS-alkyl, or RS-cycloalkyl.” Thus, the compounds in Rehse *et al.* Chemical Abstracts 106:18327 are not homologs of the claimed compounds. Accordingly, the Applicants respectfully request withdrawal of the rejection under 35 USC § 103(a) based on Rehse *et al.* Chemical Abstracts 106:18327.

**Fees**

The Applicants believe they have provided for the required fees in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any additional required fee to our Deposit Account **06-1448 Reference SPV-048.02**.


**Conclusion**

In view of the above amendments and remarks, the Applicant believes that the pending claims are in condition for allowance. If a telephone conversation with Applicant's Attorney would expedite prosecution of the application, the Examiner is urged to contact the undersigned.

Respectfully submitted,  
Patent Group  
Foley Hoag LLP

Foley Hoag LLP  
155 Seaport Boulevard  
Boston, MA 02210

Telephone: (617) 832-1000  
Telecopier: (617) 832-7000

By:   
Dana M. Gordon, PhD  
Reg. No. 44,719  
Attorney for Applicant

Date: June 9, 2006